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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,355	07/06/2001	H. Craig Dees	PHO-122	5998
<div>759005/04/2007</div> COOK, ALEX, McFARRON, MANZO, CUMMINGS & MEHLER, LTD. Suite 2850 200 West Adams St. Chicago, IL 60606			<div>EXAMINER</div> EPPS FORD, JANET L	
			<div>ART UNIT</div> 1633	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> 05/04/2007	<div>DELIVERY MODE</div> PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/900,355	<b>Applicant(s)</b> DEES ET AL.	
	<b>Examiner</b> Janet L. Epps-Ford	<b>Art Unit</b> 1633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,9-11,19,27,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9-11,19,27,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-2, 9-11, 19, 27, and 36-37 are currently pending.

#### ***Claim Rejections - 35 USC § 102***

2. The rejection of claim 1, 9-11, 19, and 27 under 35 U.S.C. 102(b) as being anticipated by Heitz et al. (US 4846789), is withdrawn in response to Applicant's amendment and arguments.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 9-11, 19, 27, and 36-37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Heitz et al. for the reasons of record.
5. Applicant's arguments filed 2-12-07 have been fully considered but they are not persuasive. Applicants traversed the instant rejection on the grounds that Heitz et al. fails to teach or suggest the claimed halogenated xanthene compounds or compositions.
6. Applicants argued that the disclosure of "one or more" substitutions at positions 4, 5, 6, 7, 2', 4', 5' and 7' is quite a stretch from the 5-8 substituents present in Applicant's high halogenated xanthenes. "[A]ccordingly, the Examiner has clearly overextended the breadth of the disclosure of Heitz," and such an overextension is improper.

7. Contrary to Applicant's assertions, the disclosure of Heitz et al. sets forth derivatives of fluorescein, wherein the derivatives of fluorescein comprises "one or more" substituents at eight different positions. Contrary to Applicant's assertions, and absent evidence to the contrary, the compositions of Heitz et al. includes the "high halogenated xanthene" compounds and compositions according to the present invention.

8. As stated in the prior Office Action, Heitz et al. discloses a photodynamic medicament comprising halogenated xanthene compounds, such as derivatives of fluorescein (Col. 4, lines 15-25). These derivatives may have one or more substitutes in the 4, 5, 6, 7, 2', 4', 5', and 7' positions selected from the group consisting of fluoro, chloro, bromo, iodo, and etc. (col. 4, lines 22-27). The disclosure therefore encompasses recited compounds such as monobromoerythrosin, tribromoerythrosin, 2',4,5,6,7,7'-tetrabromoerythrosin, and monochloroerythrosin.

Heitz et al. teach using buffers for the medicament, see col. 5, lines 10-25. With respect to using different vehicles for medicaments, such as capsules, pellets, boluses, salt blocks, see col. 5, lines 25-28.

In regards to the intended use of the claimed compositions for various treatments and administrations, absent evidence to the contrary if the prior art structure is capable of performing the intended use, then it meets the claim.

"[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Applicant's have not provided any evidence of unexpected results to render the halogenated xanthene derivatives of the instant application, comprising 5-8 substituents, unobvious over the disclosure of Heitz et al. Applicant's arguments do not take the place of evidence of unexpected results.

### ***Double Patenting***

The rejection of claims 1-2, 9-11, 19, 27 and 36-37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4, 6-7, 10-12, 14, 26-27, 29, 31-32, 35-36, 42-43, and 45-52 of copending Application No. 09/799,795, is withdrawn in response to Applicant's filing of a terminal disclaimer.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

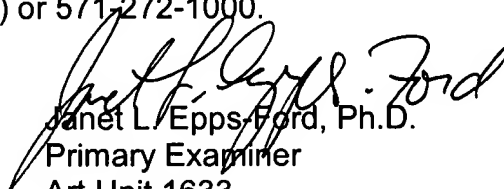
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Janet L. Epps-Ford, Ph.D.  
Primary Examiner  
Art Unit 1633

JLE